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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/920,522
Filing Date: August 02, 2001
Appellant(s): DUTTA ET AL.

Amy J. Pattillo
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 2, 2006 appealing from the Office action mailed May 4, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,855,008	Goldhaber et al.	12/1998
2003/0154171	Karp et al.	08/2003

5,987,440   O'NEIL et al.   11-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1.   Claims 1, 2, 5, 6, 11, 12, 16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldhaber et al. (5,855,008).

Regarding claim 1, Goldhaber et al. discloses a method for controlling personal information of a user using a client computer system enabled to be communicatively connected to a plurality of network entities in a network environment, comprising:

a.   storing personal information of the user at the client computer system (col 9, lines 53-67);

b.   receiving a request from a first network entity to send the personal information stored at the client to at least one other network entity (col 7, lines 11-67);

c.   enabling the at least one other network entity to be selectable by the user (col 12, lines 49-67);

d.   enabling the personal information to be edited (col 6, lines 50-65 and col 13, line 45 to cl 14, line 21); and

e.   sending the edited personal information from the client computer system to each of the selected ones of the at least one other network entity (col 7, lines 11-67).

Regarding claim 2, Goldhaber et al. discloses the method of claim 1 wherein enabling the personal information to be edited further comprises enabling the personal

information to be separately edited for each selected ones of the at least one other network entity (col 12, lines 49-67; cl 13, lines 38-59 and col 18 lines 1-15).

Regarding claim 5, Goldhaber et al. discloses the method of claim 1 further comprising receiving an indication of a remuneration from the first network entity in response to sending the edited personal information to selected ones of the at least one network entity (col 16, lines 12-24).

Regarding claim 6, Goldhaber et al. discloses the method of claim 1 wherein receiving a request further comprises receiving, with the request, a financial incentive to comply with the request (col 7, lines 11-67 and col 12, lines 49-67).

Claims 11 and 12 describe the system of the method of claim 1; therefore, the prior arts of Goldhaber et al. as set forth above are relied upon to reject claims 11 and 12.

Regarding claim 16, Goldhaber et al. discloses the computer system of claim 15 further comprising: means for receiving a second remuneration from each of the at least one other specified network entity to which the user personal information was sent (col 7, lines 11-67; col 12, lines 49-67; col 19, lines 22-67 and col 20, lines 1-58).

Claim 18 describes a program embodied on a computer readable medium of the method of claim 1; therefore, the prior arts of Goldhaber et al. as set forth above are relied upon to reject claim 18.

2.   Claims 10, 17, 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Karp et al. (US 2003/0154171 A1).

Regarding claim 10, Karp et al. discloses a method of participating in a distribution of personal information of a user in a network environment, comprising:

a.   receiving, at a second network entity, personal information of the user from the user with an indication of a requesting network entity that requested the user send the second network entity the personal information (page 2, parag. 25 and 27); and

b.   sending, from the second network entity, a second remuneration to the indicated requesting network entity in response to receiving the personal information from the user client system (page 2, parag. 25 and 27).

Claims 17 and 23 recite the system and the program embodied on a computer readable medium of the method Claim 10; therefore, the prior art of Karp et al. as set forth above in Claim 10 is relied upon to reject Claims 17 and 23.

3.   Claims 3, 4, 13 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al. in view of O'Neil et al. (5,987,440).

Regarding claim 3, Goldhaber et al. discloses the need to prevent unauthorized release of the personal information but does not explicitly mention the use of watermarking the edited personal information before sending the personal information (col 7, lines 11-67). In an analogous art, O'Neil teaches the use of digital signature to track and prevent further distribution of personal information beyond a third party (col 6, lines 29-53 and col 9, lines 27-55). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Goldhaver et al. with the use of digital signature as taught by O'Neil since it was known in the art that

a digital signature or watermark is used to securely deliver electronic documents and information thus preventing non-authorized distribution.

Regarding claim 4, Goldhaber et al. discloses the need to prevent unauthorized release of the personal information but does not explicitly mention the use of uniquely watermarking each one of the separately edited personal information before sending each of the separately edited personal information to each selected ones of the at least one network entity (col 7, lines 11-67). In an analogous art, O'Neil teaches the use of digital signature to track and prevent further distribution of personal information beyond a third party (col 6, lines 29-53 and col 9, lines 27-55). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Goldhaver et al. with the use of digital signature as taught by O'Neil since it was known in the art that a digital signature or watermark is used to securely deliver electronic documents and information thus preventing non-authorized distribution.

Claims 13 and 19 describe a system and a program embodied on a computer readable medium of the method of claim 3; therefore, the prior arts of Goldhaber et al. as set forth above are relied upon to reject claims 13 and 19.

4.   Claims 7, 9, 14, 16, 20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber et al. (5,855,008).

Regarding claim 7, Goldhaber et al. discloses a method of participating in a distribution of personal information of a user in a network environment, comprising:

a.   receiving, at a web server accessed by a user from a client system over a network, initial personal information from the user over a network (col 9, lines 53-67);

b.   sending a request from the web server to the user requesting the user to send the initial personal information of the user to at least one other specified network entity (col 9, lines 53-67);

c.   sending, with the request, an indication of a financial incentive to comply with the request (col 16, lines 12-24 and col 12, lines 49-67);

but does not explicitly disclose

d.   receiving, at the web server, a copy of the user personal information sent to the at least one other specified network entity from the user;

e.   comparing, at the web retailer, the received copy of the user personal information with the received initial personal information; and

f.   sending a remuneration, based on the comparison, from the web server to the user for complying at least in part with the request.

Goldhaber et al. discloses the use of Trading Houses implemented on a network for facilitating transactions between the buyer and the seller by matching the records from both parties, allowing the seller to directly contact the buyer and sending a remuneration (col 19, lines 20 to col 20, lines 57). Furthermore, Goldhaber et al. teaches checking and monitoring that the user has performed a requested action prior to dispensing a remuneration (col 16, lines 12-23). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Goldhaber et al., with checking that the information sent to a buyer since it was known in

the art that following up on a transaction between a first and second party by a third party is used to ensure that the terms of the specific transaction were met and thus allowing for the proper remuneration to be disbursed.

Regarding claim 9, Goldhaber et al. discloses the method of claim 8 further comprising: receiving, at a web server, a first remuneration from each of the at least one other specified network entity to which the user personal information was sent (col 7, lines 11-67; col 16, lines 12-23; col 19, lines 21-67 and col 20 lines 1-58).

Claims 14 and 16 recite the system of the method Claims 7 and 9 respectively; therefore, the prior art of Goldhaber et al. as set forth above in Claim 7 and 9 is relied upon to reject Claims 14 and 16.

Claims 20 and 22 recite the program embodied on a computer readable medium of the method Claims 7 and 9 respectively; therefore, the prior art of Goldhaber et al. as set forth above in Claim 7 and 9 is relied upon to reject Claims 20 and 22.

(10) Response to Argument

Appellants argue

A. With respect to claim 1, Appellants assert that "Goldhaber does not teach or enable each and every element of claim 1 because Goldhaber does not teach or enable receiving a request from a first network entity to send the personal information stored at the client to at least one other network entity or sending the edited personal information from the client computer system to each of the selected ones of the at least one other network entity (page 13, parag. 1).

   .a. First, Appellants describe the "attention brokerage" system recited by Goldhaber and asserts that "Goldhaber only describes the attention broker system that accesses and stores a personal profile for a user and sends the personal profile to advertisers if authorized, by the user; Goldhaber does not teach a client system that receives a request from an attention broker system for the client system to send personal information stored at the client system to advertisers" (page 14, parag. 3).

   b. Second, again referring to the "attention brokerage" system, Appellants assert that "Goldhaber does not teach or enable sending the personal information stored at the client system directly from the client system to the attention brokerage system" (page 15, parag. 1). Appellants further remark that "Goldhaber confirm that the attention brokerage system is the system that passes personal information to advertisers; Goldhaber does not teach the client system receiving a request from the attention brokerage system for the client system to send the personal information to another network entity (page 15,

parag. 2). With respect to the "trading houses" implementation, Appellants assert that "the client system does not store the personal information and therefore the client system also does not receive a request from a first network entity to send the stored information to at least one other network entity or send the information from the client system to at least one other network entity (page 15, parag. 3).

Examiner's response

The Goldhaber reference discloses several aspects: the "attention brokerage" system which is directed to giving compensations to users to watch advertisements and the information release embodiment which is directed to· selling personal information to advertisers. The latter embodiment falls within the scope of the Appellants' inventions.

Regarding claim 1, the Goldhaber evidence discloses the method of selling personal data/profile in which

a. the personal information are stored on the consumer computers (col 14, lines 47-50) which reads on step a;

b. an advertisers offer to buy personal information, "if an advertiser wants you name and address, he has to offer to buy it" (col 12, lines 50-51 and col 7, lines 5-6) which reads on step b;

c. the user has the option of accepting the offer on a "case-by-case" basis (col 12, lines 66-67) which reads on step c;

d. the user has the option to edit the personal information ("customer may edit this profile at any time to add or delete interest features", col 6, lines 57-60 and "you can edit and update your profile at any time" – see col 13, line 45 et seq.) which reads on step d;

e. the information are sent to the requesting party (col 12, lines 58-61).

The attention broker system can act as an intermediary between the advertisers and the consumers; however, the examiner remarks that the transitional term "comprising" is inclusive or open-ended and does not exclude additional, unrecited elements or method steps (see Invitrogen Corp. v. Biocrest Mfg., L.P., 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003).

In response to the Appellants' assertion of the feature of "sending the personal information stored at the client system **directly** from the client system to the attention brokerage system" (emphasis added by the examiner), the examiner remarks that the instant claim limitation is not directed to a transfer of information directly between the client computer and the requesting party. The Goldhaber evidence recites the personal information originating from the client computer (storage location) to advertisers via a network (col 9, lines 33-41 and Figure 1) thus the transfer step of Goldhaber reads on the instant claim limitation.

Appellants argue

B. With respect to claims 11, 12 and 18, Appellants assert that the claims 11 and 12 describe data processing systems executing a set of instructions with similar limitations of claim 1 and, therefore, is allowable for at least the same reasons as claim 1 and claim 18 is a computer program including similar limitations of claim 1 and, therefore, is allowable for at least the same reasons as claim 1 (page 16, parag. 3).

Examiner's response

With respect to claims 11, 12 and 18, the claims 11 and 12 describe data processing systems executing a set of instructions with similar limitations of claim 1 and, therefore, are rejected for at least the same reasons as claim 1 and claim 18 is a computer

program including similar limitations of claim 1 and, therefore, is rejected for at least the same reasons as claim 1.

Appellants argue

C. With respect to claims 2, 5, and 6, Appellants assert that claims 2, 5, 6, and 16 are also allowable for at least the same reasons that claim 1 is allowable since claims 2, 5, 6, and 16 each depend, directly or indirectly, on allowable independent claim 1 (page 17, parag. 1).

Examiner's response

With respect to claims 2, 5, and 6, the examiner notes that claims 2, 5, 6, and 16 are also rejected for at least the same reasons that claim 1 is rejected since claims 2, 5, 6, and 16 each depend, directly or indirectly, on rejected independent claim 1.

Appellants argue

D. With respect to claim 16, Appellants note that claim 16 is dependent upon claim 14 and assert that because claim 14 is allowable, as will be asserted below, claim 16, which depends directly on independent claim 14, is also allowable for at least the same reasons that claim 14 is allowable (page 17, parag. 2)

Examiner's response

With respect to claim 16, the examiner notes that claim 16 is dependent upon claim 14 and assert that because claim 14 is rejected, as will be asserted below, claim 16, which depends directly on independent claim 14, is also rejected for at least the same reasons that claim 14 is rejected.

Appellants argue

E. With respect to claim 10, Appellants assert that the Karp et al. reference does not

teach that "the requester receives the personal information from the user client system"

and "the requestor receives the personal information with an indication of a separate

requesting network entity that requested the user send the requestor the personal

information" (page 18, parag. 1).

Examiner's response

The Karp et al. evidence is directed to a method of selling personal information between

the consumer and the requester via a third party. In a network environment such as the

Internet (Fig 1B and page 2 parag. 28), Karp et al. disclose that the personal information

is received by the owner (i.e. the client) and sent to the requester (i.e. the second

network entity) via the third party (i.e. the requesting entity) (page 2, parag. 25-27). Karp

et al. further recite a validation step which is absent in claim 10; however, the examiner

remarks that claim 10 recites the transitional term "comprising" which is inclusive or

open-ended and does not exclude additional, unrecited elements or method steps (see

Invitrogen Corp. v. Biocrest Mfg., L.P., 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634

(Fed. Cir. 2003). Finally, Karp et al. disclose that the requestor (i.e. the second network

entity) provides payments to both the owner and the third party (page 2, parag. 28).

Appellants argue

F. With respect to claims 17 and 23, Appellants assert that claim 17 is a system claim

of claim 10 and claim 23 is a computer program with similar limitations of claim 10.

Examiner's response

G. With respect to claims 17 and 23, the examiner notes that claim 17 is a system claim of claim 10 and claim 23 is a computer program with similar limitations of claim 10.

Appellants argue

H. With respect to claims 3 and 4, Appellants assert that a prima facie case of obviousness has not established (page 19, parag. 1).

    a. Appellants assert that Goldhaber in view of O'Neil does not teach or suggest the watermarking feature and that the "digital signature" taught by O'Neil is not equivalent to the "digital watermark" (page 21, parag. 2).

    b. Appellants assert that there is no suggestion or motivation to modify Goldhaber by O'Neil (page 23, parag. 2) and that the rejection is based on an improper use of "hindsight" (page 24, parag. 3).

Examiner's response

a. The examiner remarks that Appellants define the watermark feature in page 25, lines 15 to 29:

> The watermark may include any type of watermarking including special textual content, background graphics, or subliminal watermarks that are invisble to the human eye. Another type of watermarking may include varying the format or content of various fields within the personal information such as changing the format of the address; or changing the description of the occupation, e.g., using "software programmer" for one Web site and "software developer" for another.

First, the Examiner notes that it is known in the art that one of the use of digital signature is as a digital watermark to ensure that the critical information (such as personal information) can be tracked. The examiner notes that the digital signature feature taught

by O'Neil is a digital pattern, or message digest that is unique to that file and is then encrypted to create a digital signature. Finally, the digital signature is attached to the sent file (col 9, lines 32-40). Therefore, the digital signature feature of O'Neil reads on the broad interpretation of the special textual content, background graphics or subliminal watermarks as disclosed by the Appellants.

In response to applicant's argument concerning impermissible hindsight, examiner asserts that "any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill at the time claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, reconstruction is proper." In re McLaughlin, 170 USPQ 209, 212 (CCPA 1971). In the instant case, the examiner remarks that the motivation to combine is based on the security and privacy features taught by Goldhaber ("protects the consumer's privacy" (col 6, line 48; "keep the contact information of each member confidential" (col 6, line 67; "no advertiser can resell his/her name without permission" (col 7, lines 4-5)). Furthermore, O'Neil is directed to the security in electronic transfer of personal information which is in the same field of endeavor as Goldhaber.

Appellants argue

I. With respect to claims 17 and 19, Appellants assert that claim 17 is a dependent system claim with similar limitations of claim 3 and claim 19 is a dependent computer program claim including similar limitations of claim 3 and, therefore, claims 17 and 19 are allowable for at least the same reasons as claim 3 (page 24, parag. 4).

Examiner's response

With respect to claims 17 and 19, the examiner notes that claim 17 is a dependent system claim with similar limitations of claim 3 and claim 19 is a dependent computer program claim including similar limitations of claim 3 and, therefore, claims 17 .and 19 are rejected for at least the same reasons as claim 3.

Appellants argue

J.   With respect to claim 7, Appellants assert that a prima facie case of obviousness has not established since Goldhaber as modified by the Examiner does not teach or suggest each and every element (page 26, parag. 1) and due to a lack of suggestion of motivation to modify Goldhaber (page 27, parag. 3):

a.   First, Appellants describe the "attention brokerage" system taught by Goldhaber and assert that Goldhaber as modified does not teach "sending a request from the web server to the user requesting the user send the initial personal information of the user to at least one other specified network entity" (page 26, parag. 3).

b.   Second, Appellants assert that "Goldhaber as modified does not teach the element of sending a remuneration, based on the comparison, from the web server to the user for complying at least in part with the request" (page 27, parag. 1).

c.   Third, Appellants asserts that the Examiner has used "hindsight" (page 27, parag. 4) as multiple modifying steps are needed (page 28, parag. 1). The Appellants asserts that the modifications are not obvious as "the attention broker of Goldhaber teaches against modification to enable the client system and the advertising system to directly contact one another because the attention broker

controls all communications, and maintains the privacy of the client unless

authorized to release selected information to the advertiser" (page 29, parag. 1).

d. Fourth, Appellants asserts that "merely because Goldhaber describes monitoring

the user's interaction with information at the client system does not suggest

modification of the attention broker to further monitor and verify communications

between the user and the advertiser" (page 29, parag. 3).

Examiner's response

The examiner remarks that Goldhaber discloses that the personal data are

stored on the user's computer and/or at the attention broker servers (col 14, lines 47-50).

Furthermore, Goldhaber discloses the attention broker being an intermediary between

the requester and the user. In the embodiment of the user being paid to watch

advertisements, Goldhaber also disclose that the attention broker monitors the user's

interaction to ensure that that the user has performed the task then disbursing the

payment upon successful completion (col 16, lines 216-20). Therefore, Goldhaber

discloses the elements and the motivation to check the pertinence and validity of the

personal data provided by the user to the requester to ensure that the terms of the

specific transaction were met and thus allowing for the proper remuneration to be

disbursed.

Regarding the direct transfer of information between the user and the requester,

the examiner remarks that the instant claim limitation is not directed to a transfer of

information directly between the client computer and the requesting party. The

Goldhaber evidence recites the personal information originating from the client computer

(storage location) to advertisers via a network (col 9, lines 33-41 and Figure 1) thus the

transfer step of Goldhaber reads on the instant claim limitation.

Appellants argue

K. With respect to claims 14 and 20, Appellants assert that claim 14 is a dependent

system claim with similar limitations of claim 7 and claim 20 is a dependent computer

program claim including similar limitations of claim 7 and, therefore, claims 14 and 20

are allowable for at least the same reasons as claim 3 (page 29, parag. 4).

Examiner's response

With respect to claims 14 and 20, the examiner notes that claim 14 is a dependent

system claim with similar limitations of claim 7 and claim 20 is a dependent computer

program claim including similar limitations of claim 7 and, therefore, claims 14 and 20

are rejected for at least the same reasons as claim 3.

Appellants argue

L. With respect to claims 9, 16 and 22, Appellants assert that claim 9, 16, and 22 each

depend, directly or indirectly, on allowable independent claims 7, 14, and 20. Therefore,

claims 9, 16, and 22 are also allowable for at least the same reason that claims 7, 14,

and 20 are allowable (page 30, parag. 2).

Examiner's response

With respect to claims 9, 16 and 22, the examiner notes that claim 9, 16, and 22 each

depend, directly or indirectly, on rejected independent claims 7, 14, and 20. Therefore,

claims 9, 16, and 22 are also rejected for at least the same reason that claims 7, 14, and

20 are rejected.

(11) Related Proceeding(s) Appendix

For the above reasons, it is believed that the rejections should be sustained.

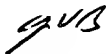Respectfully submitted,

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12/11/06

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